

REMARKS

Claims 1-10 are pending. Claims 9 and 10 are allowable subject to being rewritten in independent form.

Claims 1-8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Beranger et al. in view of Edson.

This rejection is respectfully traversed for the following reasons.

The apparatus independent claim 5 recites a transceiver for providing data communications over residential twisted pair wiring, comprising:

- an output driver having an output for supplying a transmit signal of a prescribed level to the residential twisted pair wiring, and
- an output drive control system for comparing a DC level set at the output of the output driver with a predetermined threshold signal to control the output driver so as to maintain the transmit signal at the prescribed level.

The Examiner admits that none of the references discloses a transceiver for providing data communications over residential twisted pair wiring. However, he takes the position that “as to the claimed transceiver, it is in the preamble and no patentable weight is given (sic).”

The Examiner’s position is respectfully traversed.

It is well settled that a claim preamble has the import that the claim as a whole suggests for it. When the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects. *Bell Communications Research Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 34 U.S.P.Q.2d 1816, 1820 (Fed. Cir. 1995). It is noted that the preamble of a claim is not a limitation, where the portion of the claim following the preamble is a self-contained description that does not

depend for completeness upon the introductory clause.... In those cases where the preamble to a claim is expressly or by necessary implication given the effect of a limitation, the introductory phase is deemed essential to point out the invention defined by the claim. *Kropa v. Robie and Mahlman*, 187 F2d 150, 88 U.S.P.Q. 478 (C.C.P.A. 1951).

It is respectfully submitted that the portion of the claim 5 following the preamble depends for completeness upon the preamble. In particular, the claimed language clearly indicates that the output driver and the output drive control system are elements of the transceiver for providing data communications over residential twisted pair wiring.

Moreover, the claim recites that the output driver has an output for supplying **a transmit signal** of a prescribed level **to the residential twisted pair wiring**.

Accordingly, the body of the claim recites a transmit signal supplied by the transceiver to the residential twisted pair wiring.

Hence, the body of the claim depends for completeness upon the preamble, and should be considered as a limitation.

As the Examiner appears to admit, none of the references of record discloses the claimed transceiver for providing data communications over residential twisted pair wiring.

Hence, they cannot teach or suggest the elements of the transceiver recited in the claims 5-8.

Moreover, the applied reference combination does not teach or suggest the claimed output driver having an output for supplying a transmit signal of a prescribed level to the residential twisted pair wiring.

The Examiner considers a line driver of Beranger to correspond to the claimed output driver. However, Beranger does not suggest supplying a transmit signal because it does not disclose any transmitter.

Further, the Examiner considers a voltage clamp of Beranger to correspond to the claimed output drive control system.

However, Beranger does not disclose the claimed output drive control system for comparing a DC level set at the output of the output driver with a predetermined threshold signal to control the output driver so as to maintain the transmit signal at the prescribed level, as claim 5 requires.

In particular, resistors and diode of the Beranger's clamp determine the DC threshold level at which the clamp will begin to conduct thereby establishing the maximum DC output level of the driver (see col. 8, lines 51-56).

Accordingly, Beranger does not suggest comparing a DC level set at the output of the output driver with a predetermined threshold signal to control the output signal at the prescribed level. Instead, the reference discloses limiting the output signal to the established threshold level. Moreover, the reference expressly suggests limiting the maximum DC driver output level to suppress voltage transients (see e.g. the abstract).

Moreover, as the Examiner admits, Beranger does not describe supplying a transmit signal of a prescribed level to the residential twisted pair wiring. Edson is relied upon for disclosing this feature.

However, Edson discloses a gateway for providing appropriate software interfaces for ADSL, cable and X-link lines to control various home devices over a power line or a twisted

pair. The reference does not teach or suggest supplying a transmit signal of a prescribed level to the twisted pair.

Accordingly, a combination of Beringer with Edson is not sufficient to suggest this feature.

It is well settled that the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. *In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

As demonstrated above, the combined teachings of the references would not teach or suggest the claimed transceiver for providing data communications over residential twisted pair wiring, as claim 5 requires.

Moreover, the combined teachings are not sufficient to suggest an output driver having an output for supplying a transmit signal of a prescribed level to the residential twisted pair wiring, and comparing a DC level set at the output of the output driver with a predetermined threshold signal to control the output driver so as to maintain the transmit signal at the prescribed level.

Hence, the Examiner's conclusion of obviousness with respect to claim 5 is improper.

Further, claim 1 recites a method of configuring a transceiver having an output driver for driving an output terminal to provide data transmission via residential twisted pair wiring, the method comprising the steps of:

setting a DC level at the output terminal for supplying a transmit signal of a prescribed level to the residential twisted pair wiring,

comparing a controlled value representing the DC level with a predetermined threshold level, and

controlling the output driver until the controlled value is equal to the threshold level.

As discussed below, the applied reference combination would not teach or suggest configuring a transceiver having an output driver for driving an output terminal to provide data transmission via residential twisted pair wiring, as claim 1 requires.

Moreover, the combined teachings of the references does not teach or suggest comparing a controlled value representing the DC level with a predetermined threshold level, and controlling the output driver until the controlled value is equal to the threshold level.

Instead, the prior art would suggest limiting the output signal of the driver to a threshold level established by the clamp.

Hence, the combined teachings are not sufficient to arrive at the subject matter of claim 1.

Dependent claims 2-4 and 6-8 are defined over the prior art at least for the reasons presented above connection with the respective independent claims 1 and 5.

In view of the foregoing, and in summary, claims 1-10 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

Application No.: 09/413,821

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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